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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,451	10/09/2001	Myron K. Jacobson	NIAD-201.3 DIV - AP/NDH	7369
7590 02/25/2004				
Fulbright & Jaworski LLP 666 Fifth Avenue New York, NY 10103		EXAMINER LACOURCIERE, KAREN A		
		ART UNIT PAPER NUMBER		

1635

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/973,451

**Applicant(s)**

JACOBSON ET AL.

**Examiner**

Karen A. Lacourciere

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 67-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 67-71 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT:Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 67, 68 and 71, drawn to an antibody that binds to a protein with an amino acid sequence set forth in SEQ ID NO:2, classified in class 530, subclass 387.1.
- II. Claims 67, 68 and 71, drawn to an antibody that binds to a protein with an amino acid sequence set forth in SEQ ID NO:4, classified in class 530, subclass 387.1.
- III. Claims 67, 68 and 71, drawn to an antibody that binds to a protein with an amino acid sequence set forth in SEQ ID NO:6, classified in class 530, subclass 387.1.
- IV. Claims 67, 69 and 71, drawn to an antibody encoded by a nucleic acid sequence set forth in SEQ ID NO:1, classified in class 530, subclass 387.1.
- V. Claims 67, 69 and 71, drawn to an antibody encoded by a nucleic acid sequence set forth in SEQ ID NO:2, classified in class 530, subclass 387.1.
- VI. Claims 67, 69 and 71, drawn to an antibody encoded by a nucleic acid sequence set forth in SEQ ID NO:3, classified in class 530, subclass 387.1.

- VII. Claims 67, 70 and 71, drawn to an antibody that binds to a protein comprising an amino acid sequence set forth in SEQ ID NO:11, classified in class 530, subclass 387.1.
- VIII. Claims 67, 70 and 71, drawn to an antibody that binds to a protein comprising an amino acid sequence set forth in SEQ ID NO:12, classified in class 530, subclass 387.1.
- IX. Claims 67, 70 and 71, drawn to an antibody that binds to a protein comprising an amino acid sequence set forth in SEQ ID NO:13, classified in class 530, subclass 387.1.
- X. Claims 67, 70 and 71, drawn to an antibody that binds to a protein comprising an amino acid sequence set forth in SEQ ID NO:14, classified in class 530, subclass 387.1.

The inventions are distinct, each from the other because of the following reasons:

Claims 67 and 71 link(s) inventions I-X. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 67 and 71. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are

presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the sequences listed in claims 68, 69 and 70 are subject to restriction. The Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such nucleotide sequences to be claimed in a single application. Under this policy, up to 10 of independent and distinct nucleotide sequences will be examined in a single application. (see MPEP 803.04 and 2434), however, due to the heavy search burden placed on the Office, an election of ONE single sequence is required.

Groups I-X, in claims 68, 69 and 70 are specifically drawn to antibodies that bind to a protein comprising SEQ ID NOS 2, 4, 6, 11, 12, 13, or 14, or an antibody encoded by a nucleic acid set forth in SEQ ID NO: 1, 2, or 3. Applicant is required to elect ONE of these sequences. The sequences are considered to be unrelated, since each sequence claimed is structurally independent and distinct. Furthermore, a search of more than one (1) of the sequences claimed in claims 68, 69 and 70 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed sequences. In view

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of the foregoing, one (1) sequence is considered to be a reasonable number of sequences for examination.

Because these inventions are distinct for the reasons given above and the search required for Each of Groups I-X is not required for each of the other Groups restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A. Lacourciere whose telephone number is (571) 272-0759. The examiner can normally be reached on Monday-Thursday 6:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on (571) 272-0760. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karen A. Lacourciere  
February 23, 2004

  
KAREN A. LACOURCIERE, PH.D.  
PRIMARY EXAMINER